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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,240	01/29/2001	Salman K. Khan	KHAN 4060	9177

321 7590 02/11/2005

SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER
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COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/772,240

Applicant(s)

KHAN, SALMAN K.

Examiner

Edward R. Cosimano

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/4/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

3. Claims 2-5, 11, 18, 30 & 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.1 In regard to claims 2-5, 11, 18, 30 & 32, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claims 2-4, 18, 30, and how the status information obtained in claim 1 and is limited to whether or not there is mail in the receptacle can also generate an indication of:

- (1) the number of items in the receptacle (claims 2, 18); or
- (2) the class of each item in the receptacle (claims 3, 18); or
- (3) the approximate time of delivery (claim 4); or

(4) the mail that the user has indicated should generate the status information (claim 5); or

(5) whether or not the mail in the receptacle is sorted (claim 30);

since the invention as recited in these claims has not either acquired, entered/received, determined, or set forth any means/function that could determine each of these types of information so that it could be remotely indicated to the user.

B) in regard to claim 11, and how the manually determined status information is entered into the system of claim 1 so that it may be stored and indicated to the user, since the invention as recited in these claims has not either acquired, entered/received, determined, or set forth any means/function that could accept manually determined information so that it may be stored and can be remotely indicated to the user.

C) in regard to claim 32, and how the generation of status information could occur at any point in the process of mail delivery, since the receptacle is always located at the end of the delivery process and the invention as recited in these claims has not either acquired, entered/received, determined, or set forth any means/function that could accept status information from any point in the process of delivering the mail.

3.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

4.1 Claims 2-5, 11, 18, 30 & 32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

4.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), "We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes

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merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.";

and "Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.", {emphasis added}.

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4.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the "specified adjusted location" in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

4.1.3 As can be seen from claims 2-5, 11, 18, 30 & 32, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 2-5, 11, 18, 30 & 32 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

4.2 Claims 1-32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 2-5, 11, 18, 30 & 32, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.

B) in regard to claims 1-32, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 103 as set forth below.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5.1 Claims 1-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Varga et al (5,818,336) or Adams (5,950,919) in view of either Johnson et al (6,553,336) or Karboski et al (6,772,130).

5.1.1 In regard to claims 1, 6-27 & 29-32, either Varga et al ('336) or Adams ('919) disclose a mail box monitoring system in which the status, for example, "no mail" or "mail delivered" is sensed, stored with in the components of the system and remotely indicated/messaged/announced to the user.

5.1.2 Neither Varga et al ('336) nor Adams ('919) disclose that the electrical components in the systems of are a computer, however in the environment of monitoring, either Johnson et al ('336) or Karboski et al ('130) disclose a computerized monitoring and tracking system that under the control of a program stored in the memory monitors of events that occur at various points in the network. To this end, the systems of either Johnson et al ('336) or Karboski et al ('130) collect and store the status of various sensors, where the status of the sensors indicate the status of the events of interest to the user that are being monitored and have occurred at the various points of the network. The stored status data may then be accessed by the user or the status may be provided to the user over the network. Since the user of the systems of either Varga et al ('336) or Adams ('919) may not be able to access the status of the mail from any location, it would have been obvious to one of ordinary skill at the time of the invention that the systems of either Varga et al ('336) or Adams ('919) may be modified to provide the status of the mail to the user over a network as taught by either Johnson et al ('336) or Karboski et al ('130).

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5.1.3 In regard to the type of status information provided to the user as recited in claims 2-5 & 30, since the systems of either Varga et al ('336) or Adams ('919) as modified by either Johnson et al ('336) or Karboski et al ('130) would use sensors capable of detecting an event of interest to the user, it would have been obvious to one of ordinary skill at the time of the invention that the status of any type of detectable event that may be of interest to the user may be detected and indicated to the user.

5.1.4 In regard to using the communications network to send a billing notice to the user of claim 28, since the system of either Varga et al ('336) or Adams ('919) modified to provide the status messages to the user over a network as taught by either Johnson et al ('336) or Karboski et al ('130) would not operate with insufficient funds, it would have been obvious to one of ordinary skill at the time of the invention that a message concerning the billing status of the user may be communicated to the user over the network.

6. The examiner has cited prior art of interest, for example;

A) Seeley et al (2,835,887) which discloses a sensor to detect the presence of mail in a receptacle and an means to indicate when mail is in the receptacle.

B) PRnewswire article which discloses an internet tracking system that monitors events as an is being delivered and permits the user to obtaining the stored tracking information.

C) either Varga et al (5,818,336) or Adams (5,950,919) which disclose the monitoring of a mail box and indicating the monitored status to a remote location.

D) Grauch (WO 98/3114) which discloses the monitoring of events that occur at various points in the network and storing the status of the event where the status may be provided to the user.

7. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.



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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

8.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

8.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

02/04/05

  
Edward R. Cosimano  
Primary Examiner A.U. 3629